REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Applicants have amended the last paragraph on page 3 of the specification to correct translation errors, namely the replacement of "dental prostheses" in two occurrences by -- denture teeth --. The corrections are supported by, for example, step e of original claim 1, i.e., "[s]election of 3-D data records of fabricated, previously scanned teeth from a data record D3." "Fabricated teeth" are the same as "denture teeth." Accordingly, the corrections are not believed to introduce any new matter. An early notice to that effect is earnestly solicited.

Also, to eliminate step (0), Applicants have recast claims 10-17 as new claims 19-26, respectively. In the new claims, step (0) becomes step (a), step (a) becomes step (b) and so on. Again, Applicants do not believe the new claims introduce any new matter. An early notice to that effect is also earnestly solicited.

Claims 10-18 were rejected under 35 USC § 112, first paragraph, as claiming new matter. In response, Applicants point out that step (a) of new claim 19 requires "scanning fabricated teeth to produce 3-dimensional data records of fabricated teeth." As noted above, such step is derivable from and supported by step e of original claim 1. In order to be in a position to "[select] 3-D records of fabricated, previously scanned teeth from a data record D3," it is necessary to have previously "[scanned] fabricated teeth to produce 3-dimensional data records of [the] fabricated teeth."

The Examiner misinterpreted previous step (0) to mean "scanning the teeth of a patient." As previous step (0) indicated that the recording and digitizing was of records "of fabricated teeth," it should have been clear that the scan was not of the teeth of the patient, but of fabricated teeth.

In view of the foregoing, Applicants respectfully submit that the language of the claims is supported by the original specification. An early notice to that effect is also earnestly solicited.

Claims 16 and 17 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have provided in new claims 25 and 26, which replace claims 16 and 17, respectively, that the optional steps are "carried out."

Applicants believe that the new wording of claims 25 and 26 moots the Examiner's objection. An early notice to that effect is also earnestly solicited.

Claims 10, 13 and 16-18 were rejected under 35 USC § 102(e) as being anticipated by Thomas, US 7,153,135. In response, Applicants remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, the absence in the prior art reference of even a single one of the claim elements is sufficient to negate anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants respectfully submit that Thomas fails to teach instant steps (a), (g), (k)-(m) or (n) in the process claims and the corresponding features in the apparatus claim. Therefore, Thomas cannot anticipate any of the instant claims.

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Thomas sets forth the aim of his invention at column 10, lines 15 ff. There, Thomas writes enigmatically about a data merger with data depicting an outer surface:

> "This aim is reached according to the invention when at least a full upper or lower plastic disposable artificial denture is made using digital data of an image of the oral cavity without teeth is created and merged with data depicting a specific outer surface or style and a denture is created..."

In the following paragraph, Thomas mentions different data sets, viz:

> "an actual archived model of the person's oral cavity prior to complete tooth removal or artificial elements which are added based on personal preference as a function of image information."

From column 10, line 39, onward, it becomes clear that the stored archival image must be either the previous denture the patient was wearing before being fitted a new one or his/her own natural teeth when he/she still had teeth.

However, nowhere in Thomas, US 7,153,135, is there any teaching or suggestion that stored images of prefabricated synthetic teeth are entered separately into the database, thereby creating data sets that can be individually moved separately.

Thus, Thomas does not teach or suggest the following steps of the present process:

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(a)   scanning fabricated teeth to produce 3-dimensional data records of fabricated teeth;

(f)   selecting 3-dimensional data records of fabricated teeth;

(g)   virtual placing of the teeth into the virtual model;

(k)   transferring the virtual placing of the teeth to a model either by a positioning template, or direct placement of the teeth on the model;

(l)   affixing the teeth to the model; and

(m)   attaching a denture base to the model;

(n)   without carrying out steps (k), (l) and (m), directly manufacturing a denture base, according to data for a virtual denture placement, with positioning aids for a final correct positioning and affixing of the teeth.

The Examiner places emphasis on Thomas' Data Set M, but Applicants respectfully submit that this data set is not of actually prefabricated teeth. Moreover, Thomas lacks manipulation of prefabricated teeth into a virtual model (instant step (g)) or the manipulations that are required to follow in instant steps (k)-(m) and (n).

In view of the foregoing, Applicants respectfully submit that Thomas does not anticipate the instant claims. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

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Claim 11 was rejected under 35 USC § 103(a) as being obvious over Thomas in view of Baumrind, US 6,621,491.

Claim 12 was rejected under 35 USC § 103(a) as being obvious over Thomas in view of Chishti, US 5,975,893.

Claims 14 and 15 were rejected under 35 USC § 103(a) as being obvious over Thomas in view of Jordan et al. ("Jordan"), US 6,152,731.

In response to *all three* obviousness rejections, Applicants respectfully submit that each of these rejections was dependent upon Thomas anticipating the basic aspects of the present invention, which Applicants have shown above is not, in fact, the case. There is nothing in either Baumrind or Chishti or Jordan that remedies the deficiencies of Thomas. Therefore, Applicants respectfully submit that the combination of Thomas taken in view of Baumrind or Chishti or Jordan fails to make out a *prima facie* case of the obviousness of the instant claims.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw all three obviousness rejections. An early notice that all three obviousness rejections have been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By   //Kurt G. Briscoe//

Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 33,141
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844